UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,369	10/20/2000	Joel E. Short	42253/205	8237

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EXAMINER
CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

	Application No.		Applicant(s)	
Office Action Summary	09/693,369		SHORT, JOEL E.	
	Examiner		Art Unit	
	Paul Callahan		2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>*20 October 2000*</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-4,9,10,12-14,16 and 17* is/are rejected.

7) ☐ Claim(s) *5-8,11,15 and 18-20* is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>*20 November 2000*</u> is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-20 are pending in the Application and have been examined.

Drawings

2.   The drawings are objected to because they are hand drawn and informal. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Oath/Declaration

3.   No Oath or Declaration as required under 35 USC sec.115 and 37 CFR sec.

1.51(b)(2) is in the file. The Applicant should supply a new Oath/Declaration or a copy of

the one originally filed.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a
foreign country or in public use or on sale in this country, more than one year
prior to the date of application for patent in the United States.

5.   Claims 1-4, 9, 10, 12-14, 16, and 17 are rejected under 35 U.S.C. 102(b) as

being clearly anticipated by Malkin, "Dial-in Virtual Private Networks Using Layer 3

Tunneling", IEEE, 11/1997.

As for claim 1, Malkin teaches a method for dynamically creating a tunnel in a

communications network to provide subscribers host access to a network service

(Introduction, p.555), comprising: storing a subscriber profile in a network database

(Sec. 3. Operational Algorithm, page 556, paragraph 5), wherein the subscriber profile

includes subscriber-specific network service tunneling requirements (Sec. 3.

Operational Algorithm, page 556, paragraphs 4, 5: "FQDN", Fig. 2 step 5); receiving at a

network device a first subscriber data packet associated with a first network service

(Sec. 3. Operational Algorithm, page 556, paragraphs 4,5); accessing the subscriber

profile to determine if the first network service has a subscriber-specific tunneling requirement; and creating a first tunnel if a determination is made that the subscriber profile requires a first network service tunnel (Sec. 3. Operational Algorithm page 556, fig. 4 steps 4, 5), wherein the first tunnel has a first end point at the network device and a second end point at the first network service (Sec. 3 Operational Algorithm, page 556, paragraphs 4,5).

As for claim 2, Malkin teaches the method of Claim 1, wherein storing a subscriber profile comprises storing at least one parameter chosen from the group consisting of the network access identifier, a user/subscriber name and a user/subscriber password (Sec. 3 Operational Algorithm, page 556 bottom, fig. 2 step 5).

As for claim 3, Malkin teaches the method of Claim 1, further comprising determining if a first tunnel between the network device and the first network service pre-exists prior to creating the tunnel between the network device and the first network service (Sec. 3 Operational Algorithm, page 556, paragraph 5, fig. 2 step 4).

As for claim 4, Malkin teaches the method of Claim 1, wherein more than one subscriber accessing the communication network through the network device can simultaneously transmit data packets to the first network service via the first tunnel (Sec. 6.2 Maximum User Count, page 559, 2nd paragraph).

Claims 9 and 10 represent the apparatus carrying out the method of claims 1-3, and area rejected on the same basis as those claims.

As for claim 12, Malkin teaches a network device that dynamically creates a tunnel in a communications network to provide a subscriber host access to a destination network (Sec. 1: Introduction pages 555-556), comprising: a processor that receives from a subscriber a data packet associated with a network service (Sec. 3: Operational Algorithm, page 556, paragraphs 2-4); a database accessed by the processor that stores a subscriber profile that defines the tunnel requirements for the network service (Sec. 3: Operational Algorithm, page 556, paragraphs 2-4); and a tunnel management module implemented by the processor that communicates with the database to determine if the subscriber requires a tunnel for access to the network service and, if a determination is made that the tunnel is required, the tunnel management module creates a tunnel access session between the network device and the network service (Sec. 3: Operational Algorithm, page 556, paragraphs 2-4, fig. 4 steps 4, 5).

As for claim 13, Malkin teaches the network device of Claim 12, further comprising a session management module implemented by the processor that communicates with the database to manage the tunnel access session provided by the network device (Sec. 3: Operational Algorithm, page 557, right-hand column, fig. 2, step 8).

As for claim 14, Malkin teaches the network device of Claim 12, wherein the tunnel management module determines if a tunnel between the network device and the network service pre-exists prior to creating the tunnel between the network device and the network service (Sec. 3: Operational Algorithm, page 556, paragraph 4, fig. 2, steps 4).

As for claim 16, Malkin teaches the network device of Claim 12, wherein the tunnel management module is capable of providing simultaneous access to the tunnel access session to more than one subscriber accessing the communication network through the network device (Sec. 6.2 Maximum User Count, page 559, 2nd paragraph).

As for claim 17, Malkin teaches the network device of Claim 16, further comprising a session management module implemented by the processor that communicates with the database to manage the simultaneous tunnel access session provided to more than one subscriber accessing the communication network through the network device (Sec. 6.2 Maximum User Count, page 559, 2nd paragraph).

Allowable Subject Matter

7.   Claims 5-8, 11, 15, and 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. The following US Patent documents disclose similar network

tunneling protocols to the instant application:

Valencia   US 6,308,213

Pao et al.   US 6,694,437

Brownell   US 6,754,831

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-

1336. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's

supervisor, Andrew Caldwell, can be reached on (703) 306-3036. The fax phone

number for the organization where this application or proceeding is assigned is: (703)

872-9306. Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 305-

3900.

9/13/04

Paul Callahan